



Docket No.: R2180.0189/P189
(PATENT)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Takaaki Negoro et al.

Application No.: 10/769,817

Confirmation No.: 9540

Filed: February 3, 2004

Art Unit: 2822

For: SEMICONDUCTOR DEVICE HAVING DMOS
AND CMOS ON SINGLE SUBSTRATE

Examiner: Ida M. Soward

PETITION UNDER 37 C.F.R. 1.181

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accord with 37 C.F.R. 1.181(a)(3), Applicants petition the Director to invoke his supervisory authority in consideration of the following statement of facts and action requested. As the facts at hand are not specifically provided for in the regulations of the Patent Rules, Applicants seek a decision on the merits under 37 C.F.R. 1.182 and submit the petition fee set forth in § 1.17(h).

Statement of Facts

On June 29, 2006, an Ex Parte Quayle Action was issued in this application. In the "Detailed Action" section, that Office Action states:

This application is in condition for allowance except for the presence of claim 22 directed to an invention non-elected with traverse in the reply filed on May 3, 2005. Applicant is given ONE MONTH or THIRTY DAYS¹ from the date of this letter, whichever is longer, to cancel the noted claims or to take other appropriate action (37 CFR 1.144). **Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the**

¹ During a conversation with Examiner Soward on July 31, 2006, Applicants' representative confirmed that the allotted "ONE MONTH or THIRTY DAYS" for response was incorrect; and, in fact, Applicant had two months to respond to the Office Action. See filed Communication, July 31, 2006, page 1.

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case to issue. Extension of time under 37 CFR 1.136(a) will not be permitted since **this application will be passed to issue.**

Office Action, June 29, 2006, page 2 (emphasis added). As can be seen above, the Office Action clearly states that Applicants were not obligated to reply to the Office Action. Rather, if no reply was filed, the informalities were to be addressed by an Examiner's Amendment and the application passed to issue.

As of today, the application has not been passed to issue. Further, an Examiner's Amendment has not been entered.

Over the past week (February 2-9, 2006), Applicants' representative has addressed this issue with Examiner Ida M. Soward and Supervisory Examiner Zandra V. Smith. Both Examiner Soward and Supervisory Examiner Smith have attempted to resolve the issue. Based on a conversation conducted February 8, 2006 between Applicants' representative and Examiner Soward, it is the understanding of Applicants' representative that she has taken an appropriate steps to enter an Examiner's Amendment and pass this application to issue. However, neither Examiner Soward nor Supervisory Examiner Smith can confirm (apparently due to administrative issues concerning the Office's docketing procedures) that an Examiner's Amendment has indeed been entered. Further, the Patent Application Information Retrieval (PAIR) system states the status of the application as being "Ex parte Quayle Action Mailed".

Supervisory Examiner Smith has indicated, in a conversation on February 7, 2006, that the application will become abandoned if the Examiner's Amendment cannot be entered. Applicants note that the Patent Rules prohibit such action, by stating "If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, **the application will become abandoned unless an Office action indicates otherwise.**" 37 CFR 1.135(a) (emphasis added). The Ex Parte Quayle Action clearly indicates that this application will not become abandoned.

Action Requested

In view of the above, Applicants respectfully request that the Director invoke his supervisory authority to (1) prevent the issue of a Notice of Abandonment; (2) enter an Examiner's Amendment to address the informalities addressed by the Ex Parte Quayle Action; and (3) pass this application to issue.

If a Notice of Abandonment is issued before this petition is considered, Applicants respectfully request the Director to invoke his supervisory authority to withdraw the holding of abandonment; and, further, to take the above actions (1), (2), and (3). According to the Manual of Patent Examining Procedure (MPEP), "[U]nless the circumstances warrant the withdrawal of the holding of abandonment (i.e., it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the revival of an abandoned application is a statutory prerequisite to revival of the abandoned application, and cannot be waived."

711.03(c)(II)(B) (emphasis added). Thus, under the facts at hand, no fee is statutorily required to petition for a withdrawal of abandonment.

Though no additional fees are believed to be required, the Director is hereby authorized to charge any deficiency in the fees filed (including deficiencies in connection with withdrawing a holding of abandonment), asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1073, under Order No. R2180.0189/P189. A duplicate copy of this paper is enclosed.

Dated: February 12, 2007

Respectfully submitted,

By 

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